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In re Application of:

Hochstein, James R. Jr. et al

Serial No.: 10/733,889

Filed: Dec. 11, 2003

Docket: 085.10959-US(03-429)

Title: DETONATIVE CLEANING APPARATUS

DECISION ON PETITION TO
WITHDRAW HOLDING OF
FINALITY

This is a decision on the petition filed on Oct. 17, 2007 to withdraw the finality of the Office action of Aug. 23, 2007. The petition is being considered pursuant to 37 CFR § 1.181 and no fee is required for the petition.

The petition is **DISMISSED**.

In the petition, the applicant requests withdrawal of the finality of the Office action mailed Aug. 23, 2007. The petitioner claims that the amendment of Jun. 8, 2007 incorporated a property inherent in claim 3 into independent claim 1 for clarification. The Aug. 23, 2007 Office action rejected claims including claim 3 under 35 U.S.C. 103(a) as being unpatentable over Jennings et al in view of Hunter, Jr. The examiner stated in the final Office action of Aug. 23, 2007 that the applicant's amendment necessitated the new ground(s) of rejection. Petitioner is of the opinion that this is clearly incorrect. The final Office action did not attempt to substantiate a basis for this assertion. The incorrectness can be seen, for example, in the prior rejection of claim 3 and present rejection of claims 1 and 3. Petitioner believes the new ground is necessary to reject prior claim 3 and was not made necessary by amendment. Petitioner requests the finality of the last Office action of Aug. 23, 2007 be withdrawn.

The record shows that:

1. On Mar. 16, 2007, the examiner issued a non-final Office action rejecting claims 1 and 4 under 35 U.S.C. § 102(b) over Hunter, (U.S. Pat. 5,494,004) and claims 2, 3 and 5-9 under 35 U.S.C. §103 as unpatentable over Hunter (U.S. Pat. 5,494,004) in view of Jennings et al (U.S. Pat. 2,972,502) as grounds for rejection.
2. In response to the non-Final rejection, on Jun. 8, 2007, the applicant filed an amendment adding dependent claims 16-20. In the amendment of Jun. 8, 2007, the applicant also amended independent claim 1 by inserting a phrase "against relative moment" to overcome the rejection under 35 USC 102(b) over Hunter (U.S. Pat. 5,494,004).
3. On Aug. 23, 2007, the examiner mailed a final Office action rejecting claims 1-9 and 16-20 as unpatentable over Jennings et al (U.S. Pat. 2,972,502) in view of Hunter, (U.S. Pat.

- 5,494,004) under 35 U.S.C. §103 as grounds for the rejection. In the rejection, the examiner stated that the applicant's amendment of Jun. 8, 2007 necessitated the new ground(s) of rejection.
4. On Oct. 17, 2007, the present petition was filed requesting withdrawal of the finality of the Office action mailed Aug. 23, 2007 based on petitioner's belief that the new ground is necessary to reject prior claim 3 and was not made necessary by amendment to independent claim 1.

Discussion and Analysis

Relevant portions of MPEP 706.07(a): Final Rejection, When Proper on Second Action, states:

Under present practice, second or any subsequent actions on the merits shall be final, except where *the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims* nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b).

In order to determine whether or not the amendment filed on Jun. 8, 2007 necessitated the new grounds of rejection in the final Office action of Aug. 23, 2007, a comparison of at least the amended claim 1 filed on Jun. 8, 2007 and the previous claim 1 as originally filed on Dec. 11, 2003 must be made. A review of the original claim 1 indicates that independent claim 1 was amended. The phrase "against relative moment" was added. In light of the amended claim 1, the examiner was required to search for and reconsider the prior art relating to the use of a plurality of segments secured end-to-end "against relative moment". The search strategy, search fields, consideration and application of prior art references of record are now different. The addition of the phrase "against relative moment" necessitated the new grounds of rejection by requiring a different combination of the prior art references. In this case, the amended claim 1 and other dependent claims 2-9 and newly added dependent claims 16-20 were finally rejected as unpatentable over Jennings et al (U.S. Pat. 2,972,502) in view of Hunter (U.S. Pat. 5,494,004) under 35 U.S.C. §103 as new grounds for the rejection.

Petitioner's argument is that the insertion of the phrase "against relative moment" to claim 1 is an incorporation of a property inherent in claim 3 into independent claim 1 for clarification, and therefore, the application of newly combined prior art references in the final rejection is not necessitated by the amendment to claim 1. The line of argument is not convincing. Applicant's amendment to independent claim 1 does necessitate the new grounds of rejection. In the Mar. 16, 2007 non-final Office action, the examiner rejected original claims 1 and 4 under 35 U.S.C § 102(b) over Hunter (U.S. Pat. 5,494,004) and original claims 2, 3 and 5-9 under 35 U.S.C. §103 as unpatentable over Hunter, U.S. Pat. 5,494,004 in view of Jennings et al (U.S. Pat. 2,972,502) as grounds for rejection. In response to the Jun. 8, 2007 amendment, the examiner issued a final Office action rejecting amended claim 1 and its dependent claims 2-9 and newly added dependent claims 16-20 as unpatentable over Jennings et al (U.S. Pat. 2,972,502) in view of Hunter U.S. Pat. (5,494,004) under 35 U.S.C. §103 as grounds for the rejection. The review of

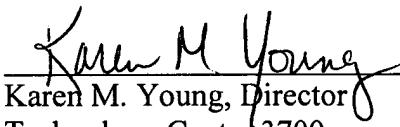
the record shows that the examiner was in compliance with proper examining practice as set forth in M.P.E.P. 706.07(a). Therefore, the amendment to the claims presented on Jun. 8, 2007 necessitated the new grounds of rejection presented in the final Office action issued on Aug. 23, 2007. The finality of the Office action is therefore appropriate.

Conclusion

For the foregoing reasons, the relief requested by petitioners will not be granted. Specifically, the examiner's finality of the Office action dated Aug. 23, 2007 is proper.

The application is being forwarded to Examiner Ndubizu of Art Unit 3749 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

The petition is dismissed.



Karen M. Young, Director
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